

**REMARKS**

The Office Action mailed April 18, 2006 has been received and reviewed. Claims 1 through 27 are currently pending in the application. Claims 10 through 27 are withdrawn from consideration. Claims 1 through 9 stand rejected. Applicants have amended claim 1. Support for the amendments may be found throughout the as-filed specification, for example, in paragraphs [0034] and [0040] through [0042]. Applicants respectfully request reconsideration of the application as amended herein.

**35 U.S.C. § 102(b) Anticipation Rejections**

**Anticipation Rejection Based on U.S. Patent 6,378,976 to Byers *et al.***

Claims 1 through 6, 8, and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Byers *et al.* (U.S. Patent 6,378,976) (hereinafter “Byers”). Applicants respectfully traverse the rejections, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding independent claim 1, Applicant asserts that Byers does not describe, either expressly or inherently, each and every element of claim 1 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Byers does not describe the element of the claimed invention calling for “designing a pattern with at least one area for receiving writing indicia.” Byers does not describe “designing a pattern.” Byers discloses printing a test pattern with a fixer. *Col. 6, lines 1-6*. Byers does not disclose a capacity to design the pattern to be printed. Additionally, Byers does not describe “a pattern with at least one area for receiving writing indicia.” The test pattern of Byers is for detecting “misdirected droplets of fixer and/or missing nozzles on the fixer pen.” *Col. 6, lines 9-10*. If the test pattern of Byers received writing indicia, then portions of the test pattern actually present may not be detected and an incorrect diagnostic would thus result. Therefore, for at least these reasons, Byers does not anticipate claim 1 under 35 U.S.C. § 102(b).

Claims 2 through 6, 8, and 9 are novel for at least the reason of depending from novel independent claim 1.

### **35 U.S.C. § 103(a) Obviousness Rejections**

#### Obviousness Rejection Based on Byers in view of U.S. Patent 6,134,025 to Takeuchi *et al.*

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Byers in view of Takeuchi *et al.* (U.S. Patent 6,134,025) (hereinafter "Takeuchi"). Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Regarding claim 7, Applicant asserts that Byers and Takeuchi, assuming combinability for the sake of argument, do not teach or suggest all of the claim limitations of independent claim 1 to establish a *prima facie* case of obviousness regarding the invention of claim 1 under 35 U.S.C. § 103, for all of the reasons discussed above with regard to the Section 102 rejections. Therefore, claim 1 is non-obvious. Claim 7 is non-obvious for at least the reason of depending from claim 1.

### **CONCLUSION**

Claims 1 through 9 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain

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which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

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